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EXAMINER

CHANNAVAJJALA, LAKSHMI SARADA

ART UNIT	PAPER NUMBER
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1615

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 01232004

Application Number: 09/341,328

Filing Date: July 06, 1999

Appellant(s): MIKAMI ET AL.

MAILED
JAN 27 2004
GROUP 2500

Terryence Chapman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10-14-2003.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows:

In addition to the issue presented by applicants in the brief, claims 12-41 are rejected under 35 USC 103(a) as being unpatentable over US Patent 5,776,497 to Lagrange et al.

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(7) Grouping of Claims

The rejection of claims 12-41 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,776,497	Lagrange et al.	424/489
5,496,544	Mellul et al.	424/78.03

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 12-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,496,544 to Mellul et al.

Mellul et al. discloses a cosmetic composition for skin consisting of a powder and a silicone resin mixture (abstract). Mellul et al. further teach that face powders and the like usually consist of colored or non-colored powders and a fatty binder, which is then applied to the skin by means of an applicator such as a sponge, powder puff or brush (c 1, l 13-23). Mellul et al. discloses a cosmetic composition with a powder comprising a solid particulate phase mixed with a fatty binder containing a silicone mixture (c 2, l 48-58). Mellul et al. teach an organic powder, which suggests applicant's claim to a natural organic powder. It is the position of the examiner that the term organic can be interpreted to mean natural, being that organic can be defined as something derived from living organisms. Therefore, Mellul et al.'s teachings to any organic

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powder render applicant's claims obvious. Additionally, the examiner refers to column 6, line 9 of the reference, which teaches that starch can be included in the powder composition as filler. Starch is a natural, organic material, and therefore fulfills the requirement for a natural, organic material in the powder composition. Furthermore applicant's claims 24-29 include specific examples of what applicant is referring to as a natural, organic powder. This list includes cellulose and collagen, among others, and is therefore rendered obvious by Mellul et al. 's teaching of starch, as well as the teaching in column 6, line 56, where Mellul et al. teach that collagen can be included in the powder composition.

It is the position of the examiner that Mellul et al 's invention reads on applicant's claims. Applicant is claiming an applicator with a powder adhered to the side which will touch the skin. Mellul et al. teach that powder puffs, applicators, and sponges are well known in the cosmetic art to apply facial powder and the like to the skin. Further, applicant claims that the powder adheres to the applicator through a treatment with a resin mixture. Mellul et al. teach a powder mixed with a silicone resin mixture (weight percents discussed in c 2, l 61), and teaches that it is applied to the skin in the usual methods (c 7, l 51-52). Mellul et al. do not teach the specific particle size of the powder. However, it is the position of the examiner that the specific particle size is a limitation that would be routinely determined by one of ordinary skill in the art, through minimal experimentation, as being suitable, absent the presentation of some unusual and/ or unexpected results. The results must be those that accrue from the specific limitations. Therefore, it is the position of the examiner that one of ordinary skill in the art would have been motivated to use a well known applicator (as discussed by Mellul et al.) to apply a cosmetic composition comprising a powder and a silicone resin mixture, as taught by Mellul et al. One of ordinary skill

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in the art would expect an improved cosmetic composition. Therefore, this invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made.

Claims 12-41, and new claim 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,776,497 to Lagrange et al.

Lagrange et al. disclose a mineral or organic particle based product, wherein the product is a powder, which consists of mineral or organic particles smaller than 200 microns (abstract). Lagrange et al. further teach that the product is to be used in cosmetics (c 1, l 10, and the reference specifically discusses the formulation's use as a powder to be applied with a powder puff or a brush (c 14, ex. 7). Although Lagrange et al. teach in general that the particles be less than 200 microns, the reference further teaches that the particles, in particular be between 1 and 20 microns (c 4, l 46). Furthermore, Lagrange et al. teach that substances such as chitin, cellulose, wool, and silk can all be included in the composition (c 5, l 35-44). Additionally, Lagrange et al. teaches that the makeup compositions of the present invention can also contain thickeners, and anionic and cationic substances (c 9, l 23-24). It is the position of the examiner that the teachings of Lagrange et al. suggest the limitations of applicant's instant claims. Although Lagrange et al. do not use the language "firmly adhered" to, for the same reasons discussed in the first rejection, this is not considered to patentably distinguish the art from the instant applicant. One of ordinary skill in the art would look to the teachings of Lagrange et al. to formulate a cosmetic composition comprising an applicator, and a powdered substance wherein the powdered substance is firmly adhered to the applicator. Without firm adherence, the

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applicator would not function as desired. Therefore, this invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made.

(11) *Response to Argument*

Applicant's arguments filed October 9, 2002 have been fully considered but they are not persuasive.

MELLUL et al :

Applicants state that the claimed skin contacting article provides a soothing feeling to the skin without causing irritation because of the natural organic material provided in a an impalpable powder form. Applicants argue that Mellul et al discloses a cosmetic composition for skin consisting of anhydrous powder and mainly including a solid particulate phase mixed with a fatty binder containing silicone mixture; and additionally states that the cosmetic composition can be used with a sponge, powder puff or a brush. Applicants argue that nothing in the reference suggests that the powder is firmly adhered to the applicator through a process of coating a treatment comprising the powder onto the base layer and drying the treatment. However, this argument is not persuasive. According to MPEP section 2113 "even though the product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production, if the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Therefore, the new limitation, drawn to the process of adhering the powder to the base layer, does not render patentable distinction to the claims. Patentable distinction may only be rendered to composition claims by

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showing that there is a material difference in the actual products. As discussed in the above rejection, it remains the position of the examiner that the cited reference does implicitly teach a powder being adhered to the based layer. Additionally, any differences to be shown between the cited product and the claimed product must be expressed in the claim language.

Applicants argue that in the context of the “ordinary” or “accustomed” meaning of the claimed terms “firmly” (securely or solidly fixed in place) or “adhered” (to hold fast or stick by or as if by gluing, suction, grasping or fusing), the organic powder of the instant article is permanently affixed to a side of the base layer of the article. Applicants also argue that nothing in the instant specification deviates from the above meaning of the phrase “firmly adhered”. Further, applicants argue that there is no basis in the teachings of Mellul et al that suggests that the powder is contained on an applicator prior to being applied to the user. Applicants’ arguments have been considered but not persuasive because as explained above, the patentability of a product does not depend on used for preparing the product and that if the product is obvious the claim is unpatentable even if the prior art uses a different process.

Applicant also argues that the reference does not teach natural, organic impalpable powder. With reference to the examiner’s interpretation that the teaching of any organic powders reads on natural organic impalpable powder, applicants’ argue that the interpretation is against the commonly accepted meaning of natural because the organic powders include “natural” as well as “synthetic”. With reference to the teaching of starch by Mellul, applicants’ argue that there is no disclosure in the reference that starch can be used in the form of an impalpable powder, other than the teaching of starch as filler. Applicants’ arguments have been considered but not found to persuasive because Mellul et al desires that the composition as a whole is in the

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form of a powder and also teaches various fillers of different particle sizes, which make up to about 95% of the composition. Accordingly, employing fillers in the form of powders (which is nothing but particles) so as to achieve a powdered composition, as desired by Mellul et al, would have been obvious for one of an ordinary skill in the art. Further, mere particle size alone does not render patentability to a composition and applicants have not established the criticality of the particle size of the organic powder. Accordingly, manipulating the size of the components of the composition so as to prepare a powdered composition would have been within the scope of a skilled artisan.

For these reasons, the above rejection has been maintained.

LAGRANGE et al :

Applicants have not appealed the rejection of claims 12-41 as being unpatentable over US Patent 5,776,497 to Lagrange et al. It therefore appears that applicants have acquiesced to the rejection.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,



Lakshmi S Channavajjala
Examiner
Art Unit 1615
January 23, 2004

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